

REMARKS/ARGUMENTS

Summary of the Office Action:

Claims 1-8, 14, 18-22, 24-46 and 55-65 are pending in the application, prior to amendment.

Claim 19 has been rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

Claims 1 and 2 have been rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,632,097 to Brooks ("Brooks").

Claims 1-4 and 8 have been rejected under § 102(b) as anticipated by U.S. Patent No. 5,081,714 to Liu ("Liu").

Claims 22 and 26-32 have been rejected under 35 U.S.C. § 102(a), or, alternatively, § 102(e), as anticipated by U.S. Patent No. 6,645,226 to Jacobs et al. ("Jacobs").

Claims 18, 19, 25, 35, 37-41 and 43-46 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Jacobs in view of Williams (Williams identified as U.S. Patent No. 6,645,226, but presumably refers to U.S. Patent No. 5,423,885 - hereinafter "Williams").

Claims 24, 35, 36, 41 and 42 have been rejected under § 103(a) as unpatentable over Jacobs in view of U.S. Patent No. 5,383,897 to Wholey ("Wholey").

Claims 5-7, 14, 33 and 34 have been objected to as depending from a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

Claims 20, 21 and 55-65 have been allowed.

Applicant's Response:

With reference to the 35 U.S.C. § 112, second paragraph, rejection of claim 19 as indefinite, Applicant has amended claim 19 to remove the phrase, "during wound healing," thereby obviating the rejection.

With reference to the § 102(b) rejections of independent claim 1 as anticipated by Brooks or Liu, as well as of dependent claim 2 as anticipated by Brooks and dependent claims 2-

4 and 8 as anticipated by Liu, those references describe hook-and-loop locking systems, e.g. Velcro™. Applicant respectfully submits that the hook elements of the hook-and-loop locking systems described by Brooks and Liu are not configured to adhere to a wound.

Applicant has amended independent claim 1 to positively recite that Applicant's claimed multiplicity of barbs are, "configured to adhere to the wound." Providing barbs configured to adhere to a wound has critical bearing on the structural make-up of Applicant's claimed apparatus. Thus, in view of the amendments to claim 1, Applicant respectfully submits that Brooks and Liu do not anticipate amended independent claim 1, nor any of the claims that depend therefrom, since they neither teach nor suggest barbs configured to adhere to a wound.

With reference to the § 102(a) rejections of claims 22 and 26-32 as anticipated by Jacobs, Applicant respectfully submits that § 102(a) has been misapplied; Applicant therefore traverses those rejections and requests their withdrawal. Jacobs issued as a patent on November 11, 2003. Applicant originally filed the present application on December 20, 2000, with a Request for Continuing Examination filed March 15, 2004. Since the Jacobs reference was patented after Applicant's original filing date (and, thus, after Applicant's invention date), Jacobs does not qualify as prior art under § 102(a).

With reference to the § 102(e) rejections of claims 22 and 26-32 as anticipated by Jacobs, Applicant has amended independent claim 22, from which claims 26-32 depend, to require, "suture extending through at least one of the plurality of perforations." Support for this amendment is found, for example, in Applicant's FIG. 10B, as well as the accompanying disclosure in Applicant's specification.

For a reference to be anticipatory, it must teach each and every element of the invention as claimed. Applicant respectfully submits that Jacobs neither teaches nor suggests a plurality of perforations adapted to define suture eyelets and having suture extending through at least one of the plurality of perforations. Rejection of claims 22 and 26-32 as anticipated by Jacobs therefore is obviated.

Referring now to the § 103(a) rejection of claim 25 over Jacobs in view of Williams, Applicant respectfully submits that the amendments to independent claim 22, from which claim 25 depends, obviate that rejection for at least the reasons discussed previously.

With reference to the § 103(a) rejections of claims 18, 19, 35, 37-41 and 43-46 over Jacobs in view of Williams, Applicant respectfully traverses those rejections and requests reconsideration (Applicant notes that the subject matter of dependent claims 37 and 43 has been amended into independent claims 35 and 41, and that claims 37 and 43 have been canceled, as discussed hereinafter).

As discussed previously in Applicant's November 7, 2003, Response to the May 9, 2003, Office action, Williams does not teach a "method of forming an anastomosis," nor does Williams teach "apparatus for closing a wound." Rather, Williams describes a coiled sheet stent adapted for positioning within a patient's blood vessel. Since Williams provides no teaching or suggestion that the stent taught therein could be used in Applicant's method of forming an anastomosis or as Applicant's apparatus for closing a wound, there is no motivation for combination with Jacobs to provide such a method or such apparatus with a therapeutic agent. As such, a prima facie showing of obviousness has not been established, the rejection being based on improper hindsight reconstruction gleaned from Applicant's disclosure.

With reference to the § 103(a) rejection of claim 24 over Jacobs in view of Wholey, Applicant respectfully submits that the amendments to independent claim 22, from which claim 24 depends, obviate that rejection for at least the reasons discussed previously. With reference to the § 103(a) rejections of claims 35, 36, 41 and 42 over Jacobs in view of Wholey, Applicant has amended independent claims 35 and 41, from which claims 36 and 42 respectively depend, to require that the elongated substrate comprises a biocompatible material, "*impregnated* with a therapeutic agent." Support for these amendments is found, for example, in canceled claims 37 and 43. Applicant respectfully submits that neither Jacobs nor Wholey, either alone or in combination, teach an elongated substrate impregnated with a therapeutic agent. Rejection of claims 35, 36, 41 and 42 in view of those references therefore is obviated.

With reference to the objections to claims 5-7, 14, 33 and 34, Applicant respectfully submits that in view of the foregoing amendments and remarks, those claims are in condition for allowance.

Appl. No. 09/746,579
Amdt. dated October 22, 2004
Reply to Office Action of June 4, 2004

PATENT

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

Johney Han
Reg. No. 45,565

By: James M. Heslin
Reg. No. 29,541

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 415-576-0300
Attachments
JMH:jke
60339306 v1